

AMENDMENT

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## Remarks

### For the Claims:

In an Office Action Summary page of this 11 August 2004 Office Action, claims 1-11 were indicated as being rejected, and claims 12-20 were indicated as being allowed. However, a review of the Detailed Action indicates that claims 4, 10, and 11 were actually objected to. Accordingly, Applicant takes this latter position, i.e., that claims 4, 10, and 11 were objected to, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant amends claims 4 and 10 herein, adds new claims 21-30, and retains claims 1-3, 5-9, and 11-20 as originally filed. Applicant acknowledges the allowance of claims 12-20, and respectfully requests reconsideration of claims 1-3, 5-9, and 11 as originally filed in view of the following remarks. In addition, Applicant respectfully requests consideration of new claims 21-30.

Claims 4, 10, and 11 were objected to as being dependent upon a rejected base claim. Claims 4 and 10 are being amended to independent form to include all limitations of the base claim and any intervening claim. Accordingly, claims 4 and 10 are allowable. Originally filed claim 11 depends from claim 10. Accordingly, claim 11 is also allowable.

In a first Office Action dated 1 March 2004 claims 1-3 and 5-9 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Chang et al.*, U.S. Pat. No. 6,463,270 (hereinafter *Chang*) in view of *Koster*, U.S. Pat. No. 6,356,756. This Office Action acknowledges that Applicant's response filed 28 March 2004 overcomes the rejection cited in the first Office Action.

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This Office Action now rejects claim 1 under 35 U.S.C. §112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Office Action alleges that claim 1 is vague. In particular, this Office Action asserts that it appears that a wireless directory number is found and, from that, a route is determined. The Office Action further points out that the Examiner feels that some crucial, and patentable, step is missing that would give the claim completeness.

MPEP 706.03(d) calls for an Examiner to supply a full explanation of the alleged deficiency of the claims. In this case, it appears that the Examiner believes claim 1 to be incomplete, although such did not appear to be the case in the 1 March 2004 Office Action. MPEP 706.03(d) further indicates that it is incumbent upon the Examiner to point out the omitted steps and to give rationale for considering that the allegedly omitted steps are critical or essential.

In this case, the Office Action does not point out any allegedly omitted steps. Although the Examiner feels that some crucial, and patentable, step is missing, the Examiner fails to provide any indication as to what that missing step might be, or what might give the claim completeness. Accordingly, it is difficult for Applicant to ascertain what type of response would be favorably viewed by the Examiner. If the below-presented remarks are deemed not to be persuasive, the Examiner is respectfully invited to more clearly point out what the allegedly missing step might entail.

As set forth in MPEP 2173.02, the essential question under 35 U.S.C. 112, second paragraph, is whether the claims meet the

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threshold requirements of clarity and precision. However, definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. As stated in Ex parte Wu, 10 USPQ 2d 2031, 2033 (B.P.A.I. 1989):

In rejecting a claim under the second paragraph of 35 U.S.C. 112, it is incumbent on the examiner to establish that one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims.

Thus, well-establish patent practice dictates that the claims must be analyzed, not in a vacuum, but in light of the supporting specification. The subject matter of independent claim 1 is set forth in Applicant's specification on page 26, line 28, through page 30, line 18. This passage sets forth a clear description of the receiving, identifying, obtaining, utilizing, and establishing operations of claim 1.

This Office Action asserts that it "appears that a wireless directory number is found and, from that, a route is determined." Claim 1 recites the limitation of "utilizing said wireless DN to determine a route that includes said originating switching node and a visited switching node serving said wireless DN." Support is found for the claim 1 "utilizing" limitation in Applicant's specification on page 28, line 27, through page 30, line 4.

In particular, the cited passage teaches that the home location register (HLR) utilizes the wireless DN to determine which visitor location register (VLR) is presently serving the

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wireless station having the wireless DN. The HLR continues to utilize the wireless DN by sending a routing request to the identified VLR. If the call is deliverable, the VLR returns a temporary local directory number (TLDN) to the HLR in a RouteRequest response message. Thus, the wireless DN is again utilized since this exchange of routing request and route request response messaging relates the TLDN with the wireless DN. Upon receipt of the TLDN, still associated with the wireless DN, the HLR recovers the local access DN from the database utilizing a pointer that points from the wireless DN in a first database to the local access DN in a second database. Again, the wireless DN is still being utilized to determine a route for establishing a connection.

The route is not being determined from the wireless DN, as alleged in this Office Action. Rather, the wireless DN is being utilized to determine a route, i.e., the wireless DN is being utilized as a vehicle for the appropriate exchange of information needed to determine a route. Accordingly, claim 1 is clear and precise when viewed in connection with Applicant's specification.

For the reasons set forth above, Applicant believes that claim 1 is not indefinite. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 1 under 35 U.S.C. §112, second paragraph. Moreover, since no prior art rejection has been made, claim 1 should be found allowable.

Claims 2-3 and 5-9 depend directly or indirectly from claim 1. This Office Action only specifically rejects claim 1 under 35 U.S.C. §112, second paragraph, and fails to provide any rational for a rejection of claims 2-3 and 5-9. Consequently, Applicant believes that in light of withdrawal of the rejection of claim 1 under 35 U.S.C. §112, second paragraph, claims 2-3 and 5-9 should also be found allowable.

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New claims 21-30 are being added to include limitations directed toward utilizing the wireless DN to identify a visited switching node serving the wireless DN, and determining a route that includes the originating switching node and the visited switching node. Claims 21-30 are supported in Applicant's specification on page 26, line 28, through page 30, line 18. Since the Examiner has already indicated the allowability of subject matter set forth in claims 1-20, the same should be true of new claims 21-30.


Accordingly, this Amendment amends claims 4 and 10. Currently-amended claims 4 and 10 remain in the application and are believed to be allowable. In addition, claims 1-3, 5-9, and 11 remain in the application as originally submitted and are believed to be allowable. Furthermore, previously allowed claims 12-20 remain in this application as originally filed.

Applicant believes that the foregoing remarks are fully responsive to the rejections recited in the 11 August 2004 Office Action and that the present application is in a condition for allowance. Accordingly, reconsideration and allowance of the present application is respectfully requested.

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To the extent necessary a petition for extension of time under 37 C.F.R. 1.136 is hereby made, the fee for which should be charged to patent office deposit account 07-2347. Any other fees or charges necessary in connection with this amendment should likewise be charged to that account.

Respectfully submitted,

  
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